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10/010,102	11/08/2001	Sean J. Egan	D7655-00002	5752

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EXAMINER	
GREENE, DANIEL LAWSON	

ART UNIT	PAPER NUMBER
3694	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/010,102	EGAN, SEAN J.	
	Examiner	Art Unit	
	DANIEL L. GREENE	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/9/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-22 are pending. Applicant's 12/09/2008 response to the Non-Final Office action mailed 6/09/2008 is acknowledged and has been entered.

Response to Amendment

2. Applicant's amendment to the specification and arguments in support thereof have been considered and are persuasive. Accordingly the objection to the specification set forth in sections 2-4 of said previous Office action is hereby withdrawn.

Response to Arguments

3. Applicant's arguments with respect to the 35 USC 101 rejection set forth in section 5 of the previous Office action mailed 6/9/2008 have been fully considered but they are not persuasive.

Applicant's amendments to the claims have done nothing to concretely tie the claimed method to a particular machine or apparatus. Applicant has merely added generic, non-specific, limitations that do not connote any particular "computer" whatsoever. Again, per the specification as filed, paragraph [0011] "The method my be carried out manually, but preferably is implemented in software." Software is unpatentable, per se.

Accordingly the rejection has been sustained as set forth below.

4. Applicant's arguments with respect to the 35 USC 112 rejection set forth in sections 6-8 of the previous Office action mailed 6/9/2008 have been fully considered but they are not persuasive.

It is not seen wherein applicant set forth a clear and concise manner to determine the rating. The Examiner has reviewed the alleged sections of the specification for support and cannot find any definite, clear and concise manner in which to assign a rating. That is, applicant has failed to set forth where in the specification as filed there is set forth at least one clear and concise manner of assigning a rating, The specification fails to teach how one would determine whether to give a value of 1 or 2 or 5 or 6. The specification fails to disclose how one would differentiate between any of the ratings or how specifically the ratings would be determined.

Accordingly the rejections have been sustained as set forth below.

5. Applicant's arguments with respect to the 35 USC 103 rejection set forth in section 9 of the previous Office action mailed 6/9/2008 have been fully considered but they are not persuasive.

Accordingly the rejection has been sustained as set forth below

First, applicant alleges that APA fails to teach or suggest "futures". Applicant is directed to page 9 of the previous Office action.

"[0006] The method and system of the invention employs financial futures in ranking or assessing various investments. **Financial futures provide information on expected future returns in various investment areas or asset classes**. For example, a financial future on the S&P 500 for the period

Second, applicant attempts to overcome the Examiners reliance on "Official Notice". This is neither persuasive nor acceptable per MPEP 2144.03(c)

"To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b)"

"A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate."

It is not seen wherein Applicant has either specifically pointed out the supposed errors OR articulated why the facts presented by the Examiner are NOT considered common knowledge.

Further, applicant's arguments amount to nothing more than a general allegation that the claims define a patentable invention as applicant has NOT set forth any specific limitations NOT found in rejection set forth in section 9 of said previous Office action.

Regarding the information cited on pages 14 and 15, these definitions were cited for applicant's convenience to show what was known in the financial art. These are nothing more than old and well known definitions of terms used in the financial art and are considered to be of LOW knowledge in the art.

Regarding the information on pages 17 and 18 of the previous Office action, applicant is directed to the first paragraph of page 16.

Regarding claims 2, 6, 8, 13 and 19, the following definitions were captured from pages 488-489 of the Dictionary of finance and investment terms, Fifth edition, Copyright 1998, and clearly disclose that ratings are applied to each and every fund.

6. Applicant's arguments with respect to the 37 CFR 1.105 requirement for information have been fully considered and are persuasive, accordingly said requirement is hereby withdrawn.

Claim Objections

7. Claims 8-11 are objected to because of the following informalities: the dependencies of these claims should be amended as discussed and set forth in section 1 of said previous Office action.

8. Claim 12 is objected to because the first iteration of the term "the computer" lacks antecedent basis.

9. Appropriate correction is required.

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

11. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Currently claims 1-11 are not tied to a particular machine or apparatus. Further, claims 1-11 do not appear to transform a particular article to a different state or thing. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir 2008)

A method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. As clarified in *Bilski,* the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, ***or*** (2) transforms a particular article to a different state or thing. This is called the **"machine-or-transformation test".**

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

See the discussion of this topic in section 3 above.

Claim Rejections - 35 USC § 112

12. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in section 6 of the previous office action mailed 6/9/2008.

See the discussion of this topic in section 4 above.

13. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the reasons set forth in section 7 of the previous office action mailed 6/9/2008.

See the discussion of this topic in section 4 above.

14. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons set forth in section 6 of the previous office action mailed 6/9/2008.

See the discussion of this topic in section 4 above.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2002/0046144 A1 to Graff.

Regarding Claims 1, 7, 12 and 18, Graft teaches a system , storage apparatus and method for assigning ratings (see Pare [0067] and [0101}) to a fund (see Pare [0048] and [1545]) comprising the steps of:

operating a computer to calculate (see Pare [2152] and [2211]) an expected return (see Pare [0164] and [0289]) over a time period (see Pare [0553] and [0748])for a sector (see Pare [1108] and [2043]) corresponding to the fund based on financial futures (see Pare [0215] and [0222]) corresponding to the sector;

operating a computer to calculate an expected range of returns (see Pare [0164] and [0289]) for the sector (see Pare [1108] and 12043]) based on prices of options (see Pare [0111] and [0117]) for the futures;

operating a computer to calculate (see Para [2152] and [2211]) an expected return (see Para [0164] and [0289]) for the fund over a time period (see Para [0553] and [0748]) based on the calculated (see Pare [2152} and 12211]) expected return for the corresponding sector, the expected range of returns (see Para [0164] and [0289]) for the

corresponding sector; and on Information (see Pare [0427] and [0450]) specific to the fund, assign (see Pare [0430] and [0437J) a rating based on the expected return for the fund and provide the assigned rating to the user (see Pare [1643], [1654], etc.).

Regarding claims 2, 8, 13 and 19, Graft teaches the said method, wherein said Information (see Pare [0427"] and [0450]) specific to the fund (see Pare [0048] and [1545]) Includes an annual return adjustment factor (see Para [2217] and [2259]) equal to the difference (see Pare [2055] and [2152]) between the annualized returns (see Pare |0137] and [0140]) for the fund and a median return (see Pare [0137] and |0140]) for other funds In the sector (see Pare [1108] and [2043]).

Regarding claims 3, 9, 15 and 20, Graft teaches the said method, wherein said Information {see Para [0427] and [0450]) specific to the fund (see Para [0048] and [1545]) includes a factor (see Pare [0218}-[0219]) for the extent to which the fund's returns (see Pare [0137] and [0140]) are below the median for that sector (see Pare [1108] and [2043]) for a time period (see Pare [0553] and [0748]}.

As to Claims 4, 10, 16 and 21, Graft teaches the said method, wherein, In the step of calculating (see Para [2152] and [2211]) expected annual returns (see Pare [0164] and [0289]) for the fund (see Pare [0048] and [1545]) an adjustment (see Pare [2217] and [2259]) for qualitative factors (see Pare [0218]-[0219]) is made.

As to Claims 5, 11, 17 and 22, Graft teaches the said method, wherein said step of calculating (see Pare 12152] and [2211]) an expected annual return (see Pare [0164] and [0289]) comprises the steps of calculating a low (see Pare [0015]) and a high (see Pare [0011]-[0012]} expected annual return.

As to Claim 6, Graft teaches the said method, wherein said step of assigning (see Para [0430] and [0437]) a rating {see Pare [0067] and [0101]) comprises assigning (see Para [0430] and [0437]) one of a plurality of ratings (see Parr [0067] and [0101]) to each fund (see Pare [0048] and [1545]).

As to Claim 7, Graft teaches the said method further comprising providing (see Pare [0495] and [0500]) the rating (see Pare [0067] and [0101]) to a participating user (see Pare [1643] and [1654]).

Claim Rejections - 35 USC § 103

17. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) in view of Official Notice for the reasons set forth in section 9 of the previous office action mailed 6/9/2008.

See the discussion of this topic in section 5 above

Double Patenting

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

20. Claims 1-22 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-25 of copending Application No. 12/078,395.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

21. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 12/09/2008 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./
Examiner, Art Unit 3694
2009-03-27

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694